

**REMARKS**

The present remarks are in response to the Office Action of September 13, 2005.

Claims 1- 22 are currently pending.

Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, the Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the Office Action, the following rejections were issued:

- (1) Claims 1-8, 11-18, 21 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over GB Patent No. 2,316,682 (hereinafter "Dickinson") in view of U.S. Patent No. 5,395,432 (hereinafter "Nelson"); and
- (2) Claims 9, 10, 19 and 20 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Rejections under 35 U.S.C. 103(a)**

Before discussing the rejections under 35 U.S.C. 103(a), it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing some motivation in a prior art reference to modify that reference, or combine that reference with multiple references, to teach all the claim limitations in the instant application. Applicants respectfully assert the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in this rejection.

Claims 1-8, 11-18, 21 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson in view of Nelson. In particular, the Examiner has cited Dickinson because Dickinson recites an invisible ink-jet ink composition. Specifically, the Examiner has stated that Dickinson teaches a first invisible composition configured to be ink-jetted onto a substrate to form a first invisible image and a second invisible composition configured for over-stricking at least a portion of the invisible image, wherein the first and second invisible compositions are further configured to react and

form a second visible image. The Applicants respectfully disagree that Dickinson teaches this concept as alleged by the Examiner. In particular, Applicants respectfully submit that Dickinson teaches ink-jetting an invisible composition on to a substrate to form an invisible image, wherein the invisible ink-jet ink composition comprises a fluorescent dye and the invisible image becomes visible upon exposure to Ultra Violet Light.

In contrast, the present invention claims an ink-jet printing system which may comprise, for example, (a) a substrate; (b) a visible ink-jet ink composition configured to be ink-jetted onto at least a portion of the substrate to form a first visible image on the substrate; (c) a first invisible composition configured to be ink-jetted onto at least a portion of the substrate to form an invisible image on the substrate, said invisible image being associated with the first visible image; and (d) a second invisible composition configured for over-striking at least a portion of the invisible image, wherein the first and second invisible compositions are further configured to react and form a second visible image on the substrate. The Dickinson reference fails to teach a second invisible composition that is configured to react with the first invisible composition to form a second visible image on the substrate. Additionally, Dickinson lacks the teaching that a second composition could be used or that they intended for a second composition to react with the first composition. Dickinson specifically uses a fluorescent dye with the invisible composition such that the invisible composition would become visible upon exposure to UV light. In other words, Dickinson uses UV light to make the invisible image visible instead of a second composition that reacts with the first invisible composition to form a visible image.

Nelson teaches a latent image printing process which applies a latent image ink composition to a substrate with an ink jet printer. Subsequently, the latent image is activated to render it visible by application of an activator. The latent image can be activated by an activator that is an activating liquid or by applying heat depending on the nature of the latent image composition. The Nelson reference fails to teach that the latent image printing system is configured to print a visible in-jet ink composition onto a substrate to form a visible image and ink-jetting an invisible ink composition onto the substrate such an invisible image is formed and associated with the visible image. The Nelson invention is merely an ink-jet printing system for printing secure latent images such as production dates, lot numbers, batch numbers, and serial numbers. Notably,

Nelson lacks the teaching of ink-jetting a visible image and associating an invisible image with an ink-jetted visible image.

This being said, it is the Applicant's position that these references are not properly combinable. First, both references lack the proper motivation to modify or combine the references to arrive at the presently claimed invention. As the Examiner is aware, without the proper motivation to combine the reference or to modify them to arrive at the present invention, the presently claimed invention can not be obvious in view of the cited references. Specifically, as mentioned, Dickinson teaches of a printing system that uses invisible ink and a black light to make the invisible ink visible. The invisible ink is never "developed" using a chemical, but rather is just manipulated using ultraviolet light to bring the image into the visible spectrum. There is no teaching or suggestion in Dickinson that would lead one skilled in the art to consider forming invisible images that can be chemically developed. For example, Dickinson teaches of using a black or other colored ink with the invisible ink in embodiments where "multi-colored invisible images may be printed in conjunction with black visible images, for instance to hide an image under black text, or to print black-light posters which have some visible text, for instance, the title, author and copyright notice." Underlining added. Other similar embodiments are also provided. These teachings do not provide a suggestion for using a chemical developer as set forth in Nelson. Specifically, hiding an invisible image with black text using the invisible ink of Nelson would destroy the function of the invisible image, as the black text would not allow a chemically developed invisible image to be rendered visible. Further, a black-light poster does not suggest the use of a chemical developer, as posters are not designed to be written on by viewers, such as by using a chemical developer. In other words, there is no suggestion in Dickinson to chemically develop the invisible ink, nor is there any suggestion that the ink can be chemically developed. Further, there is no suggestion in Nelson that the chemically developable ink can be printed, and associated with, an ink-jettable visible image. Therefore, it is respectfully requested that this rejection be withdrawn.

With specific reference to method claim 11, and the system set forth in claim 21, various elements are also missing from Dickinson and Nelson. Claim 11 requires over-striking the invisible image, and the invisible image is associated with the visible image. Therefore, the method implicitly requires that two visible images be present, one of

visible ink and the other of invisible ink that has become visible by over-striking. These two visible images are associated with one another. Neither Dickinson nor Nelson teach this element. Regarding claim 21, the visible image that is printed is in the form of a character, and the invisible image is printed so as to be associated with the visible image, i.e. the character. Once the invisible image is rendered visible, it is in the form of a highlight, an underline, or a combination thereof. This element is also not present, even in the combination suggested by the Examiner. Reconsideration of these claims is respectfully requested on these grounds.

**CONCLUSION**

In view of the foregoing, Applicants believe that claims 1-22 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains, and such impediment could be resolved during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond at (541) 715-0159, or the undersigned attorney, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 13<sup>th</sup> day of December, 2005.

Respectfully submitted,



Gary P. Oakeson  
Attorney for Applicant  
Registration No. 44,266

THORPE NORTH & WESTERN, LLP  
8180 South 700 East, Suite 200  
Sandy, Utah 84070  
(801) 566-6633

On Behalf Of:  
HEWLETT-PACKARD COMPANY  
1000 NE Circle Blvd., m/s 422B  
Corvallis, OR 97330-4239  
(541) 715-0159